



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
Washington, D.C. 20231  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/497,957	02/04/2000	Winston J. Thomas	8907-087-999	8113

20583 7590 02/11/2003

PENNIE AND EDMONDS  
1155 AVENUE OF THE AMERICAS  
NEW YORK, NY 100362711

EXAMINER

DECLoux, AMY M

ART UNIT PAPER NUMBER

1644

12

DATE MAILED: 02/11/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/497,957		<b>Applicant(s)</b> THOMAS ET AL.	
	<b>Examiner</b> Amy M. DeCloux		<b>Art Unit</b> 1644	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1) ☒ Responsive to communication(s) filed on 22 November 2002.

2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4) ☒ Claim(s) 92-137 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.

6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.

7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.

8) ☒ Claim(s) 92-137 are subject to restriction and/or election requirement.

**Application Papers**

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) ☐ All   b) ☐ Some \* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

1) <input type="checkbox"/> Notice of References Cited (PTO-892) 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____. 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) 6) <input type="checkbox"/> Other: _____
---	--

### DETAILED ACTION

Applicant's election in Paper No. 10, filed 11-22-02, of the species of a plasmid comprising a sequence unique to SEQ ID NO:1, 3, 5, or 7 of Group A is acknowledged. However, Applicant is required to elect a species from each of Groups A, B, C and D outlined in the restriction requirement mailed 7-1-02, (Paper No. 8). For clarification purposes, said restriction requirement is repeated below.

#### *Election/Restrictions*

This application contains claims directed to the following patentably distinct species of the claimed invention:

A) A plasmid comprising a sequence unique to SEQ ID NO:1, 3, 5 or 7 or the complement thereof, or a plasmid comprising a sequence unique to SEQ ID NO:9, 10, 11, or 12;

Applicant is required to elect a **specific group** of sequences ie either the group comprising SEQ ID NO:s 1, 3, 5, or 7 or the group comprising SEQ ID NO:s 9, 10, 11 or 12, as recited in newly added claims 92-101 and 124-137. It is noted that the first group of sequences are genomic and the second group are cDNA.

B) A plasmid comprising an oligonucleotide comprising a sequence unique to SEQ ID NO:1, 3, 5 or 7 or a plasmid comprising an oligonucleotide comprising a sequence unique to SEQ ID NO:9, 10, 11, or 12;

Applicant is required to elect a **specific group** of sequences ie either (SEQ ID NO:s 1, 3, 5, or 7 as recited in newly added claims 102-112 , or SEQ ID NO:s 9, 10, 11 or 12 as recited in

Art Unit: 1644

newly added claims 113-123. It is noted that the first group of sequences are genomic and the second group are cDNA.

C) A plasmid comprising an oligonucleotide comprising at least 8, 9, 10, 11, 12, 13, 14, 15, 16, 17 or 18 consecutive nucleotides;

Regardless of which group is elected in part B of this species requirement, applicant is required to elect a plasmid comprising an oligonucleotide comprising a **specific number** of consecutive nucleotides such as one of the numbers recited in newly added claims 102-123.

D) ) A plasmid comprising an oligonucleotide comprising a sequence unique to SEQ ID NO:s 1, 3, 5, or 7 or to SEQ ID NO:s 9, 10, 11 or 12;

**\*\*Regardless of which group is elected in part B of this species requirement, applicant is required to elect a plasmid comprising an oligonucleotide comprising a **specific sequence** unique to SEQ ID NO:s 1, 3, 5, or 7 or to SEQ ID NO:s 9, 10, 11 or 12.**

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for each of Groups A, B, C and D, for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, all newly added claims 92-137 are generic in at least one aspect.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Art Unit: 1644

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Art Unit: 1644

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amy M. DeCloux whose telephone number is 703 306-5821.

The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 703 308-3973. The fax phone numbers for the organization where this application or proceeding is assigned are 703 305-3014 for regular communications and 703 305-7401 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703 308-0196.

*Amy DeCloux 2-10-03*  
Amy DeCloux, PhD,  
Patent Examiner, Group 1640,  
February 10, 2003